REMARKS

This amendment is responsive to the Office Action dated December 17, 2009, and received in this application. Claims 41-49 and 52-58 have been cancelled. New claims 59-74 have been added. *This amendment adds no new matter.* Support for this amendment may be found variously throughout the Specification, including, but not limited to paragraphs [0112] - [0123] of the Specification as contained in U.S. Pub. No. 2006/0013967 A1. Claims 40 and 59-74 remain pending in the application. Reconsideration and allowance of the pending claims is respectfully requested.

Claims 40-58 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,689,458 to Mikoshiba '458 et al ("Mikoshiba '458") and U.S. Patent No. 6,025,958 to Yamaoka et al ("Yamaoka") in view of U.S. Patent No. 6,411,344 to Fujii et al ("Fujii").

In view of the cancellation of claims 41-58, Applicant submits the rejection of claims 50 and 51 is moot, and thus requests that the rejection of claims 41-58 be withdrawn.

Concerning claim 40, "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In this rejection, this burden has not been met.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *see also* MPEP 2143.03.

Independent claim 40 recites: *[a] transparent conductive laminate comprising:*

a film made of a polymer with a photoelastic constant of no greater than $70 \times 10^{-12} Pa^{-1}$ *(polymer film A),*

a light-scattering layer with a haze value in the range of 0.2-1.4% formed directly on one side thereof, and

a transparent conductive layer formed on the other side thereof,

wherein the laminate exhibits a λ/4 retardation,

wherein an optical interference layer comprising a high refractive index layer and a low refractive index layer is formed between said polymer film A and said transparent conductive layer so that said transparent conductive layer is in contact with the low refractive index layer side, the high refractive index layer and low refractive index layer are both made of crosslinked polymers

wherein a cured resin layer is between said first polymer film and said transparent conductive layer, and wherein said cured resin layer contains first fine particles having a mean primary diameter of 0.5-5 μm and second fine particles having a mean primary diameter of no greater than 100 nm, and

wherein said cured resin has a first fine particle content of at least 0.3 part by weight and less than 1.0 part by weight to 100 parts by weight of a cured resin component.

The relied upon references, either alone or in any permissible combination, fail to disclose or suggest the features recited in claim 40. Specifically, the cited references, either alone or in any permissible combination, fail to disclose or suggest "*wherein said cured resin layer contains first fine particles having a mean primary diameter of 0.5-5 μm and second fine particles having a mean primary diameter of no greater than 100 nm.*"

Mikoshiba discloses a moveable transparent conductive laminate including a polarizer 10, a cross-linked polymer layer 5, a polycarbonate film 4, a cross-linked polymer layer containing fine particles 6, and a transparent conductive layer 8 with a cross-linked polymer layer having a high refractive index 9 and a cross-linked polymer layer having a low refractive index 7 between the cross-linked polymer layer containing fine particles 6 and the transparent conductive layer 8, the cross-linked polymer layer having a high refractive index 9 in contact with the cross-linked polymer containing find particles 6. (Mikoshiba, col. 5, ll. 25-37; *see also* Mikoshiba FIG. 2).

Mikoshiba further discloses that "wherein the fine particles [6] have an average diameter of 2 to 4 μm." (Mikoshiba, col. 3, ll. 56-57, col. 4, ll. 13-14, col. 8, ll. 65-66, and claim 5). Mikoshiba

also discloses "[t]he preferable average diameter of the fine particles is 2.0 to 3.8 μm.". (Mikoshiba, col. 9, ll. 7-8). Mikoshiba further discloses embodiments including "silicon cross-linked particles (produced by GE Toshiba Silicone Co., Tospearl 130) having an average diameter of about 3 μm, acryl cross-linked particles (Negami Kogyo Kabushiki Kaisha, Artpearl F5P) having an average diameter of about 3.4 μm, and silicone cross-linked particles (GE Toshiba Silicone Co., Tospearl 145) having an average diameter of about 4.5 μm[.]" (Mikoshiba, col. 16, l. 64 - col. 17, l. 3).

But as the Office Action admits, Mikoshiba makes no mention whatsoever of "*[a] cured resin layer contain[ing] first fine particles having a mean primary diameter of 0.5-5 μm and second fine particles having a mean primary diameter of no greater than 100 nm.*" (Office Action, p. 10, ll. 21-22 ("Mikoshiba does not specifically recite the use of first and second fine particles[.]").

In addressing this deficiency, the Office Action asserts:

> [I]t is the examiner's opinion that not all of the particles added to the cross-linked polymer layer (A) recited would be uniform in size and shape. Accordingly, this cured resin layer would have contained at least a first and second type of fine particles, some of which having a primary diameter of less than 100 nm.

(Office Action, p. 10, l. 22 - p. 11, l. 3).

However, the "examiner's opinion" clearly extends beyond that which is disclosed by Mikoshiba. Because the examiner's opinion has no foundation in Mikoshiba, it must be based either on inherency or on the Examiner's personal knowledge.

Concerning reliance on the theory of inherency, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112(IV) (emphasis in original); *see also In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

If the examiner's opinion relies upon the theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Office Action fails to provide a basis in fact and/or technical reasoning to reasonably support any determination that Mikoshiba's cured resin contains at least a first and second type of fine particles, the second having a primary diameter of less than 100 nm. Accordingly, the Examiner cannot rely upon a theory of inherency.

If the examiner's opinion is based on personal knowledge, U.S. patent practice and procedures dictate:

> When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

37 C.F.R. §1.104(d)(2); *see also* MPEP § 2144.03.

Accordingly, Applicant respectfully requests that the Examiner provide an affidavit to support the personal knowledge described in the above cited examiner's opinion.

In additional to the examiner's opinion based on a theory of inherency or personal knowledge, the Office Action asserts a theory of optimization, stating:

> [I]t would have been obvious to one of ordinary skill in the art to optimize the haze value for [the cross-linked particle containing film disposed on the transparent polymer substrate] by modifying the result effective variables of particle size and concentration to obtain the highest levels of fringe reduction and anti-glare properties.

(Office Action, p. 10, ll. 3-7; *see also* p. 11, ll. 4-9).

But it is well established that "[a] particular parameter must be first recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." MPEP § 2144.05 II. B.; *see also In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Applicant notes that the Office Action identifies "particle size and concentration" as the result effective variables. Yet the Office Action's optimization assertion is flawed in that it misidentifies the claimed result-effective variables.

Claim 40 does not merely recite fine particles within a single range, as disclosed by Mikoshiba, but first fine particles having a diameter within one range and second fine particles having a diameter within a second range, specifically, "*first fine particles having a mean primary diameter of 0.5-5 μm and second fine particles having a mean primary diameter of no greater than 100 nm.*" In other words, claim 40 does not merely recite particle *size* as a result effective variable, but particle *sizes*.

While Mikoshiba discloses fine particles having an average diameter of 2 to 4 μm, Mikoshiba makes no mention whatsoever of differing particles having different mean primary diameters. Thus Mikoshiba thus fails to recognize "*contain[ing] first fine particles having a mean primary diameter of 0.5-5 μm and second fine particles having a mean primary diameter of no greater than 100 nm*" as a result-effective variable.

Consequently, it cannot be maintained that it would have been obvious to one or ordinary skill in the art to modify the particle size of Mikoshiba to include two types of particles of differing sizes to optimize the haze value of the cross-linked particle containing film.

Yamaoka is relied upon in the rejection of claim 40. However, Yamaoka fails to remedy the deficiencies of Mikoshiba. Yamaoka discloses a laminated wavelength plate having "a plurality of oriented films of oriented films giving a retardation having a wavelength half that of monochromatic light laminated with their optical axes crossing each other, wherein the dependence of the birefringence differences Δn_1 and Δn_2 of the oriented films on wavelength each satisfy the relationship $\Delta n_1 / \Delta n_2 < 1.05$ based on light having wavelength of 400 nm (Δn_1) and 550 nm (Δn_2)." (Yamaoka, col. 3, lines 11-18.)

However, Yamaoka, like Mikoshiba, fails to disclose or suggest fail to disclose or suggest "*a cured resin layer contain[ing] first fine particles having a mean primary diameter of 0.5-5 μm and second fine particles having a mean primary diameter of no greater than 100 nm.*"

Fujii is also relied upon in the rejection of claim 40. However, Fujii, like Yamaoka, fails to remedy the deficiencies of Mikoshiba. Fujii discloses a transparent touch panel having a pair of transparent conductive substrates and a retardation film. (Fujii, col. 2, lines 28-47.)

However, Fujii, like Mikoshiba and Yamaoka, fails to disclose or suggest fail to disclose or suggest "*a cured resin layer contain[ing] first fine particles having a mean primary diameter of 0.5-5 μm and second fine particles having a mean primary diameter of no greater than 100 nm.*"

Because Mikoshiba, Yamaoka, and Fujii, either alone or in any permissible combination, fail to disclose all features recited by claim 40, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 40 under 35 U.S.C. § 103(a).

New claims 59-74

New claim 59-74 have been added. Claim 59 recites: *[a] transparent conductive laminate comprising:*

a cured resin layer containing two types of fine particles,

a film made of a polymer with a photoelastic constant of no greater than 70 x 10-12 Pa^{-1} (polymer film A),

a light-scattering layer with a haze value in the range of 0.2-1.4% formed on one side of polymer film A, and

a transparent conductive layer formed on the other side of polymer film A,

wherein the laminate exhibits a λ/4 retardation.

For reasons similar to those given above, amended independent claim 59 is also believed to be in condition for allowance.

Specifically, the relied upon references fail to disclose or suggest "*a cured resin layer containing two types of particles[.]*"

As described above, Mikoshiba discloses that "wherein the fine particles [6] have an average diameter of 2 to 4 μm." (Mikoshiba, col. 3, ll. 56-57, col. 4, ll. 13-14, col. 8, ll. 65-66, and claim 5).

Mikoshiba also discloses "[t]he preferable average diameter of the fine particles is 2.0 to 3.8 μm." (Mikoshiba, col. 9, ll. 7-8). Mikoshiba further discloses embodiments including "silicon cross-linked particles (produced by GE Toshiba Silicone Co., Tospearl 130) having an average diameter of about 3 μm, acryl cross-linked particles (Negami Kogyo Kabushiki Kaisha, Artpearl F5P) having an average diameter of about 3.4 μm, and silicone cross-linked particles (GE Toshiba Silicone Co., Tospearl 145) having an average diameter of about 4.5 μm[.]" (Mikoshiba, col. 16, l. 64 - col. 17, l. 3).

But Mikoshiba fails to disclose "*a cured resin layer containing two types of particles[.]*"

Similar to claim 40, Yamaoka and Fujii fails to remedy the deficiencies of Mikoshiba because neither disclose or suggest "*a cured resin layer containing two types of particles[.]*"

Accordingly, claim 59 is believed to be in condition for allowance.

Dependent claims 60-74, which depend from claim 59, are believed to be in condition for allowance for their incorporation of the features of independent claim 59 as well as for their separately recited patentably distinct features. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.)

CONCLUSION

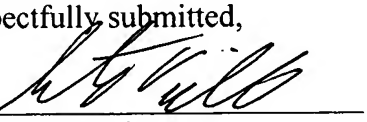
In view of the above amendment and remarks, Applicants believe the pending application is in condition for allowance. Reconsideration and allowance are respectfully requested.

This response is believed to be a complete response to the Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of the claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully requests that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

Except for the fee for a one-month extension, Applicants believe no additional fee is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 18-0013, under Order No. TEI-0132 from which the undersigned is authorized to draw.

Dated: April 19, 2010

Respectfully submitted,

By 

Sterling D. Fillmore
Registration No.: 63,796
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 23353
Representative for Applicants